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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,450	09/14/2005	Daniel Weber	2005_1431A	5519
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WENDEROTH, LIND & PONACK LLP. 2033 K. STREET, NW SUITE 800 WASHINGTON, DC 20006			EXAMINER	
			DEGA, MURALI K	
			ART UNIT	PAPER NUMBER
			3685	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,450	<b>Applicant(s)</b> WEBER ET AL.
	<b>Examiner</b> Murali K. Dega	<b>Art Unit</b> 3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 September 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1448)  
 Paper No(s)/Mail Date 20050914
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of Claims***

1. Claims 1-20 are pending and have been examined.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 is indefinite because the claim is considered a hybrid claim. See MPEP §2173.05(p) II. Specifically, the claim is directed to an apparatus (i.e. system) and recites both structure and method steps. However, it has been held claim which is intended to embrace both product or machine and process is precluded by language of 35 U.S.C. 101, which sets forth statutory classes of invention in alternative only. (Ex parte Lyell, 17 USPQ2d 1548(Bd. Pat. App. & Int. 1990); IPXL Holdings LLC v. Amazon.com Inc., 77 USPQ2d 1140 (Fed. Cir. 2005)).

5. Claims 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

- Storing usage rules.

6. Claim 11 is directed to a method and recites "Wherein when a challenge, which is a request for proof of a license, is received, the session manager generates a

certificate verifying the license and sends the generated certificate to the receiver" (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)). However, there is no indication as to who is receiving the challenge and who the receiver of the certificate is. It is unclear to one of ordinary skill who the receiver of challenge and who the receiver of the certificate. For the purposes of examination the examiner has interpreted this as a license monitoring module within the user computer acting as a session manager, generating and sending the verification to the user computer.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-3, 6-13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable by Tanaka et al. (US 20020114466).

9. With regards to claim 1 and 11:

10. Tanaka discloses a data protection management system and method enabling data communication of a license and encrypted content between a sender and a receiver while protecting and managing the communicated data (Abstract), the data protection management system comprising:

- A session manager for executing a process for acquiring a license and encrypted content from a sender (Abstract, figs. 4, 6, ¶¶ [0085], [0094], [0116] and [0117]).
- A license management engine for storing and managing the license acquired by the session manager (Abstract, fig. 2, ¶¶ [0007] and [0117]).
- Memory for storing the license (¶¶ [0077] and [0117]).
- Wherein when a challenge, which is a request for proof of a license, is received, the session manager generates a certificate verifying the license and sends the generated certificate to the receiver. Scope is unclear as the claim reads on the process that reads to challenge, but not actually challenged. Also, optional language such as "wherein" and "when", does not limit the scope of a claim or claim limitation (MPEP § 2106 II C).

11. With regards to claim 2 and 12:

12. Tanaka discloses a data protection management system as described in claim 1, further comprising a usage rules administrator for determining usage rules related to the license, and applying the usage rules to processing at least one of the license and content (¶¶ [0093], [0121] and [0125]).

13. With regards to claim 3 and 13:
14. Tanaka discloses a data protection management system as described in claim 1, wherein the session manager encrypts the certificate (Fig. 2 item 24, ¶¶ [0011], [0077] and [0199]).
15. With regards to claim 6 and 16:
16. Tanaka discloses a data protection management system as described in claim 2, wherein the usage rules include information for determining, based on the license, data to be added to the certificate (¶¶ [0093], [0121], [0125], [0128], [0132] and [0136]).
17. With regards to claim 7 and 17:
18. Tanaka discloses a data protection management system as described in claim 1, wherein the session manager, when a license change is received from the sender, reads the license before the change from the license management engine, changes the license, and saves the changed license in the license management engine (Fig. 10, ¶¶ [0107], [0108] and [0131]).
19. With regards to claim 8 and 18:
20. Tanaka discloses wherein session manager uses the key (e.g. use of 'device node key) to decrypt content (Fig. 19, ¶¶ [0007] and [0010]).
19. With regards to claim 9 and 19:
21. Tanaka discloses wherein session manager re-encrypts the decrypted content (Figs. 2, 41, 42, ¶¶ [0280]-[0282]).
22. With regards to claim 10 and 20:

23. Tanaka discloses wherein key used for re-encryption is generated based on information (e.g. EKB) from the sender (¶ [0280]).

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 4,5 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka as applied to claims 1-3, 6-13 and 16-20 above, and further in view of Doherty et al (US 6920567).

26. With regards to claim 4 and 14:

27. Tanaka discloses a data protection management system but does not explicitly disclose adding an optional item from the license to the certificate. However, Doherty teaches (Col. 19, ll. 15-24) adding certain product and license information in process of re-encryption in 10E of the user system 10B. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention, to have combined the system of Tanaka and Doherty to develop a content protection system where the user client adding an optional item during the re-encryption process in order to prevent unauthorized usage or copying of protected content, Since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation nor risk of unexpected results.

28. With regards to claim 5 and 15:

29. Tanaka discloses a data protection management system but does not explicitly disclose optional item data being encrypted using a key contained in the license. However, Doherty teaches (Col. 19, ll. 15-32) adding certain product and license information in process of re-encryption in 10E of the user system 10B for electronic distribution with embedded key contained in the license. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention, to have combined the system of Tanaka and Doherty to develop a content protection system where the user client adding an optional item during the re-encryption process in order to prevent unauthorized usage or copying of protected content. Since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation nor risk of unexpected results.

***Examiner's Comments***

30. Applicant's claims are replete with functional data and intended use language. For example, claims 1, 7, 11 and 17 are directed to a data protection management system, however a (whereby/wherein) clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. Such language does not limit the scope of a claim or claim limitation (MPEP § 2106 II C).  
31. Claim 10 recites a step for "executing". The scope is unclear as the claim reads on the process that recites executing but not actually executed.

***Conclusion***

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. PG Pub no. 20030226012 to Asokan et al discloses on-demand authorization of access to the licensed content as part of a digital rights management system.
- U.S. PG Pub no. 20040174996 to Tewfik et al discloses a digital rights management system of providing access to controlled content through encryption and associated usage rules.
- U.S. PG Pub no. 20040128499 to Peterka et al discloses a digital rights management system that uses distributed authentication for localized management and control.
- U.S. PG Pub no. 20040187014 to Molaro discloses a content repository, an encryption server to encrypt the content, a license server to create a content license for each playback device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Murali K. Dega whose telephone number is (571)270-5394. The examiner can normally be reached on Monday to Thursday 7.30 to 4.00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on (571)272-6709. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. K. D./  
Examiner, Art Unit 3685

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685

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